

Application No.: 10/635,413

Docket No.: JCLA11963

REMARKS**I. Present Status of the Application**

In the Office Action, the Examiner made the following objections and rejections: Drawings are objected to; claims 1-17 are rejected under U.S.C. § 112; under 35 U.S.C. § 102(b), claims 1-6 and 15 are rejected as being anticipated by SAM Manual, and claim 1 is rejected as being anticipated by Shimuzu et al. (US 5,913,633); and under 35 U.S.C. § 103(a), claims 7, 16 and 17 are rejected as being unpatentable over SAE Manual, claim 7 is rejected as being unpatentable over Shimuzu et al., and claims 1-17 are rejected as being unpatentable over Niebling et al. (US 5,725,285) in view of SAE Manual.

Upon entry of the amendments in this response, the drawings, and claims 1, 2, 7 and 17 are amended, and claims 15 and 16 are canceled. Claims 1-14 and 17 remain pending in the present application. Claims 1 and 7 are amended to further define that the induction hardened area is “formed locally in an area” in the bottom portion of the mouth portion of said outer joint member, and is “formed on a surface substantially perpendicular to the axial direction” in which the stem portion extends. Claim 2 is amended to correct a typographical error. The limitation of “locally in an area” is supported by, for example, the specification, in paragraph [0042], lines 1-2 (“the bottom portion 33 of the mouth portion is locally subjected to induction hardening (induction hardened area C”)); and Fig. 1 (area “C”). The limitation of “substantially perpendicular” is supported by, for example, Fig. 1.

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Applicants believe that the foregoing amendments do not introduce new matter and do not require any new search. Thus, reconsideration of those claims is respectfully requested.

II. Response to Objections and Rejections

A. Objections to the drawings

The Office Action, at page 2, objected the drawings. The Examiner states that Figs. 5 and 6 should be designated by a legend such as "Prior Art," and that the reference numeral 3b appears in specification but not in the drawings.

Applicants have made corresponding drawing corrections by adding the legend "Prior Art," and changing the numeral "3" to "3b" in Figs. 5 and 6. Such corrected drawings should have been attached to the prior amendments filed July 16, 2004, with which the corresponding corrections (changing reference numeral "3" to "3b") in specification have been filed. Therefore, Applicants respectfully submit that the objection has been overcome and should be withdrawn.

B. Rejections under 35 U.S.C. 112

The Office Action rejected claims 1-17 under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. The Examiner stated that claims 1 and 7 each recite "an induction hardened area is formed locally in the bottom portion of the mouth portion of said outer joint member," and that Applicants has not pointed out where the limitation "locally" is

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supported, nor does there appear to be a written description of the limitation in the application as originally filed. The Examiner further rejected claim 17 as being indefinite.

Regarding claims 1 and 7, Applicants respectfully submit that support of the limitation “locally” recited in claims 1 and 7 can be found, for example, in the originally filed specification, in paragraph [0042], lines 1-2 (“the bottom portion 33 of the mouth portion is locally subjected to induction hardening (induction hardened area C”)); and in the original Fig. 1 (area “C”) as well. Regarding claim 17, amendment is made for clarity.

Therefore, the grounds of rejections have been addressed and the rejections overcome. Reconsideration and withdrawal of the rejections are respectfully requested.

C. Rejections under 35 U.S.C. § 102(b)

The Office Action rejected, under 35 U.S.C. § 102(b), claims 1-6 and 15 as being anticipated by SAM Manual, and claim 1 as being anticipated by Shimuzu et al. (US 5,913,633). Applicants respectfully traverse the rejection as applied to the amended claims for at least the reasons set forth below.

To anticipate a claim, the prior art reference must teach each and every element of the claim. M.P.E.P. § 2131.

The independent claim 1, as amended, recites: “an induction hardened area is formed locally in an area in the bottom portion of the mouth portion of said outer joint member, and is formed on a surface substantially perpendicular to the axial direction in which the stem portion extends” (emphasis added). Here, the induction hardened area is “formed locally in an area” in

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the bottom portion, and is "formed on a surface substantially perpendicular to the axial direction." SAE may be arguably disclose that the hardened area is formed "locally in the surface" of the bottom portion, but does not teach that the hardened area is formed in a "locally in an area" (i.e., in a local area) of the bottom portion of the mouth portion. On the other hand, Shimizu et al. teach that a hardened area is formed in a polygonal surface or a serrated surface (surface 8 in Figs. 2A and 4A or surface 10 in Fig. 3A; col. 2, lines 19-21 and 54-56), which surfaces are parallel with, rather than perpendicular to, the axial direction in which the stem portion extends.

Please be noted that claim 15 is canceled because the limitations recited therein has been incorporated into claim 1.

Therefore, the cited references do not anticipate the amended claim 1 and claims dependent thereon, since the references do not disclose each and every element of the claim. Accordingly, Applicants respectfully submit that the grounds of rejection have been addressed and the rejection has been overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

D. Rejections under 35 U.S.C. § 103(a)

The Office Action rejected, under 35 U.S.C. § 103(a), claims 7, 16 and 17 as being unpatentable over SAE Manual, claim 7 as being unpatentable over Shimuzu et al, and claims 1-17 as being unpatentable over Niebling et al. (US 5,725,285) in view of SAE Manual.

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Applicants respectfully traverse the rejection as applied to the amended claims for at least the reasons set forth below.

To establish prima facie obviousness of a claimed invention, all the claim limitation must be taught or suggested by the prior art. M.P.E.P. § 2143.

Similar to claim 1, as mentioned in the foregoing section, the independent claim 7, as amended, recites: “an induction hardened area is formed locally in an area in the bottom portion of the mouth portion of said outer joint member, and is formed on a surface substantially perpendicular to the axial direction in which the stem portion extends” (emphasis added). Here, the induction hardened area is “formed locally in an area” in the bottom portion, and is “formed on a surface substantially perpendicular to the axial direction.” SAE may be arguably disclose that the hardened area is formed “locally in the surface” of the bottom portion, but does not teach that the hardened area is formed in a “locally in an area” (i.e., in a local area) of the bottom portion of the mouth portion. On the other hand, Shimizu et al. teach that a hardened area is formed in a polygonal surface or a serrated surface (surface 8 in Figs. 2A and 4A or surface 10 in Fig. 3A; col. 2, lines 19-21 and 54-56), which surfaces are parallel with, rather than perpendicular to, the axial direction in which the stem portion extends.

Apparently, the claimed invention is significantly distinguishable from the teachings of the prior art references since the references have not taught or suggested the claimed features as mentioned above. Therefore, the amended claim 7 and the claims dependent thereon are not rendered obvious over the cited prior art references.

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Please be noted that claim 16 is canceled because the limitations recited therein has been incorporated into claim 7.

Accordingly, Applicants respectfully submit that the grounds of rejection have been addressed and the rejection has been overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

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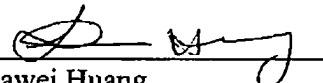
CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,
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